

R E M A R K S

- Claims **34 – 45, 50, and 51 - 53** are currently pending in the Application.
- Of the pending claims, only claims **34, 42, 50, 51 and 52** are independent.
- All pending claims stand finally rejected.
- All independent claims have been amended herein.
- Claims **54 – 57**, each of which is dependent, have been added herein.

1. RCE

The present correspondence is being filed as a Response to a Final Office Action. In order to ensure consideration and entry of the amendments and remarks of the present correspondence, a Request for Continued Examination, in accordance with 37 C.F.R. 1.114 is being filed herewith.

2. Section 101 Rejection

Claim **52** stands rejected under 35 U.S.C. §101 because “the claimed invention is directed to non-statutory subject matter”. Applicants respectfully traverse this rejection for the same reasons that applicants traversed the §101 rejection in the Response to the Office Action mailed December 26, 2002 (the “Previous Office Action” herein). However, merely for purposes of expediting the allowance of the pending claims, claim **52** has been amended herein to recite “the agreement specifies a periodic compensation amount that the expert will receive in exchange for electronically providing a minimum number of diagnoses during a time period”. Accordingly, the §101 rejection is believed to be overcome.

3. Section 102 Rejection

Claim **52** stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,324,516 to Shults et al. (“Shults” herein). Applicants respectfully traverse this rejection. The following claimed feature, particularly the aspects emphasized, is not taught or suggested by Shults:

establishing an agreement with an expert, wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for electronically providing a minimum number of diagnoses during a time period, the agreement being unassociated with any particular patient at the time of being established

In Shults, the UR agreements “specify the type and quantity of medical treatments relating to a specific claim resulting from a specific injury.” (Abstract). In other words, a UR agreement is established for a particular patient and his injury. In the embodiment of amended claim **52**, an expert establishes an agreement to provide a minimum number of diagnoses during

a time period but the agreement is unassociated with any particular patient at the time of being established. In other words, the agreement simply specifies that the expert is to provide the minimum number of diagnoses during the time period, and the patients for which the diagnoses will be provided are not part of the agreement (as they may be unknown at the time of the agreement).

Although Applicants maintain the position that claim **52** before the amendments made herein is patentable over Shults, at least for the reasons set forth in the Response to the Previous Office Action, Applicants have amended claim **52** herein to expedite allowance of claim **52** and to claim a particular embodiment of the present invention.

Since claim **52** is not anticipated by Shults, and neither Mayaud or Echerer teach or suggest establishing an agreement that is unassociated with a particular patient at the time it is established (as discussed in detail in Section 4 below), Applicants respectfully submit that claim **52** is now in condition for allowance.

4. Section 103 Rejection

4.1. Claims 34 – 41, 50 and 51

Claims **34 – 41, 50, and 51** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud (“Mayaud” herein) in view of U.S. Patent No. 6,324,516 to Shults et al. (“Shults” herein) and in further view of U.S. Patent No. 6,046,761 to Echerer (“Echerer” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

4.1.1. Independent Claims 34, 50 and 51

4.1.1.(a) References Do Not Teach or Suggest All Claim Features

The suggested combination of prior art does not teach or suggest each of the features of the pending claims. In particular, none of the references, alone or in combination, teach or suggest the following feature, which is generally recited in each of independent claims **34, 50, and 51**:

establishing an agreement with an expert, wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for providing a minimum number of diagnoses during a time period, the agreement being unassociated with any particular patient at the time of being established

As discussed in Section 3 above, a UR agreement in Shults is established for a particular patient and his injury. Echerer does not teach any agreement with an expert at all, and all requests for diagnoses are associated with the particular patient using the remote station at a given time. As acknowledged by Examiner, Mayaud does not teach establishing an agreement with an expert. (Current Office Action (Paper No. 10) page 4, paragraph 15).

Accordingly, Applicants respectfully submit that each of independent claims 34, 50 and 51 are now in condition for allowance.

Although Applicants maintain the position that claims 34, 50 and 51 before the amendments made herein are patentable over Shults and the other references of record, at least for the reasons set forth in the Response to the Previous Office Action, Applicants have amended claims 34, 50 and 51 herein to expedite allowance of these claims and to claim particular embodiments of the present invention.

4.1.1.(b). No proper motivation to combine the references as suggested

Applicants respectfully maintain the position that the statements of motivation to combine the references as provided are insufficient to satisfy the burden of establishing a *prima facie* case of obviousness. The statements are merely statements of advantages or desirable results that may be realized via the suggested combinations. However, no particular findings of why one of ordinary skill in the art, without the benefit of first having read Applicants' disclosure, would have made the combination have been provided in the record.

See, for example, the following excerpt from a Board of Appeals opinion:

"The examiner's position can be stated basically to be that the modification of [the prior art reference] necessary to arrive at the claimed invention would have been obvious to the artisan because it would improve efficiency, performance, and reliability of the [prior art reference method]. While this result indicated by the examiner is undoubtedly correct, it is not a valid basis for the rejection of a claim. It explains more why appellant wishes to patent such a process. Since most inventions are designed to improve efficiency, performance or reliability, the examiner's analysis would make it very difficult to patent anything." (Ex Parte Bowen, Appeal No. 96 – 1349).

In the present Application, Applicants respectfully assert that Examiner's assertions are not proper statements of a motivation to combine but are merely conclusory statements of desirable results that may be achieved from the proposed combinations / modifications and thus Examiner has failed to satisfy the *prima facie* burden of the obviousness rejection.

4.1.2. Dependent Claims 35 – 41

Each of claims 35 – 41 is dependent from independent claim 34. Accordingly, each of claims 35 – 41 includes all of the features of independent claim 34. Applicants thus respectfully submit that each of claims 35 – 41 is patentable at least for the same reasons as discussed with respect to independent claim 34 above.

4.2. Claims 42 – 45

Claims 42 – 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Echerer in view of U.S. Patent No. 5,216,596 to Weinstein ("Weinstein" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

4.2.1. Independent Claim 42

4.2.1.(a). References Do Not Teach or Suggest All Claim Features

The suggested combination of prior art does not teach or suggest each of the features of the pending claims. In particular, none of the references, alone or in combination, teach or suggest the following features, which are each generally recited in each of independent claim 42:

- (i) wearing the at least one telemetry device during regular daily activities;
- (ii) receiving an indication from the entity that an anomaly has occurred in at least one of the physiological parameters, the anomaly having been automatically analyzed by a computing device and an expert selected and contacted by the computing device based on the analysis

Regarding feature (i), Echerer does not teach or suggest wearing at least one telemetry device during regular daily activities. Rather, Echerer discloses that a patient may visit a remote station that includes a variety of devices that enable transmission of information between the patient and a doctor. However, in order to take advantage of the system, the patient in Echerer must come to the location of the remote station and utilize the devices attached to that station. Echerer does not suggest or enable a patient to wear at least one telemetry device during regular daily activities, but is rather limited to utilizing a device at the designated location of the remote station while attempting to obtain a diagnosis. Weinstein does not teach wearing at least one telemetry device at all, much less doing so during regular daily activities.

Regarding feature (ii), neither Echerer or Weinstein teach or suggest an anomaly being automatically analyzed by a computing device, much less an expert being selected and contacted by the computing device based on the analysis. In both Echerer and Weinstein a human being, particularly a medical professional, analyzes any information transmitted from a remote device. Neither Echerer or Weinstein enable or suggest having a computing device perform any analysis of information.

Feature (ii) is advantageous over the prior art in that it allows a computing device "to make a preliminary decision about whether or not an expert, such as a physician, should be contacted and to decide which physician to contact." (Specification as filed, page 2, lines 16 – 20). Thus, a human being does not have to be available and relied upon to analyze signals in order to make such preliminary decisions, making the system of the claimed embodiments much more efficient than the prior art systems. The claimed embodiments are further advantageous in that they do not rely on a patient contacting an expert and requesting a doctor, which is only done once a patient realizes that something is wrong or might be wrong. Rather, the claimed

embodiments allow a patient to go on about their regular daily activities, secure in the knowledge that a computing device is automatically analyzing any anomalies in the physiological parameters of the patient and contacting experts as necessary. (Specification as filed, page 5, lines 5 – 29).

4.2.1.(b). No Proper Motivation To Combine

Applicants respectfully submit that no proper motivation to combine Echerer with Weinstein has been provided, for the same reasons as discussed in Section 4.1.1(b).

4.2.2. Dependent Claims 43 - 45

Each of claims 43 – 45 are dependent from independent claim 42. Accordingly, each of claims 43 – 45 include all of the features of claim 42. Applicants thus respectfully submit that each of claims 43 – 45 is patentable at least for the same reasons discussed with respect to claim 42, above.

5. New Dependent Claims

The new dependent claims 53 – 57 are directed to embodiments wherein a request for a diagnosis is transmitted after a computing device automatically analyzes a detected anomaly in a physiological parameter of the patient, the anomaly being detected based on a signal received from a telemetry device being worn by the patient. The embodiments are fully supported by the specification as filed (see, for example, the Specification as filed, page 5, lines 5 – 29) and offer advantages not available in the prior art systems, as described in Section 4.2.1.(a) above. Additionally, each of claims 53 – 57 is dependent from a respective independent claim discussed above, and is patentable at least for the same reasons as the independent claim from which it depends.

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at mfincham@walkerdigital.com.


Petition for Extension of Time to Respond

Applicants hereby petition for a two-month extension of time with which to respond to the Office Action. Please charge \$210.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date


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